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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/764,530 | 01/17/2001 | Robert Berliner | 169-274 | 6423 |

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FULBRIGHT AND JAWORSKI L L P
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| EXAMINER |
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LANEAU, RONALD

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| ART UNIT | PAPER NUMBER |
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3627

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,530

Applicant(s)

BERLINER, ROBERT

Examiner

Ronald Laneau

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-11,14-17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5-11, 14-17, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/04/05 has been entered.

Status of Claims

2. Claims 19 and 20 are added, and claims 1, 5-11, 14-17, 19 and 20 are now pending.

Claim Rejections - 35 USC §101

3. Claims 1, 5-11, 14-17, 19 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1, 5-11, 14-17, 19 and 20 only recite an abstract idea. The recited steps of merely deriving revenue from making one or more of said items of information available by one or more of the following activities (a) direct sale, (b) obtaining referral and (c) gathering consumer information does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to derive revenue.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces scores for various steps (i.e., repeatable) used in doing business on the World Wide Web (i.e., useful and tangible).

Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or an article of manufacture to perform all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. Claims 1, 5-11, 14-17, 19 and 20 include the use of technology (i.e., world wide web or web site) in a trivial fashion. Claims 1, 5-11, 14-17, 19 and 20 do not functionally interrelate technology with the method steps.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1, 5-11, 14-17, 19 and 20 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5-11, 14-16, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koprowski (Wall Street Journal, 1998) in view of Allsop U55970472.

As to claim 1, Koprowski discloses: a method (p. 3 of 4) of doing business on the world wide web, comprising: providing information on a web site about the repair of various devices wherein a user can click on displayed graphics representing a replaceable part of a device, said graphics being in the form of a photograph or other illustration depicting the device, depicting a plurality of parts thereof, and depicting the relationship of said parts to the device, wherein when clicking on a displayed part, the user can purchase the part needing replacement; and deriving revenue from making one or more of said items of information available by one or more of the following activities: (a) direct sale of one or more replacement parts to the user, (b) obtaining referral fees or commissions from a manufacturer or other vendor of the one or more of the parts, or (c) gathering consumer information from the user's activities on the web site.

As to claim 5, Allsop teaches: wherein the user is directed to a web site of the manufacturer or vendor.

As to claim 6, Allsop teaches: wherein the web site of the manufacturer or vendor is its Site home page.

As to claim 7, Allsop teaches: wherein the web site of the manufacturer or vendor is a site page on which information on the product is displayed.

As to claim 10, Koprowski discloses and Allsop teaches: wherein by clicking one of the manufacturers or vendors, the user is directed to an order page.

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As to claim 11, Koprowski discloses: an internet web site, comprising: a plurality of web site pages providing information about the repair of various devices wherein a user can click on displayed graphics representing a replaceable part of a device, said graphics being in the form of a photograph or other illustration depicting the device, depicting a plurality of parts thereof, and depicting the relationship of said parts to the device, wherein when clicking on a displayed part, a user can purchase the part needing replacement by clicking clickable regions on one or more web site pages enabling revenue to be derived from making one or more of said items of information available by one or more of the following activities: (a) direct sale of one or more replacement parts to the user, (b) obtaining referral fees or commissions from a manufacturer or other vendor of the one or more of the parts, or (c) gathering consumer information from the user's activities on the web site.

Allsop teaches: information comprising a list of a plurality of manufacturers or vendors of the item selected by the user is made available to the user, and wherein the user can obtain information about the item or purchase the item by clicking one of the manufacturers or vendors in the list.

As to claim 14, Allsop teaches: wherein the user is directed to a web site of the manufacturer or vendor.

As to claim 15, Allsop teaches: wherein the web site of the manufacturer or vendor is its site home page.

As to claim 16, Allsop teaches: wherein the web site of the manufacturer or vendor is a site page on which information on the part is displayed.

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As per claims 19 and 20, Koprowski discloses a method wherein by clicking on the name of a manufacturer, model part numbers are displayed as claimed.

6. Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koprowski (Wall Street Journal, 1998) in view of Allsop (US5970472), and further in view of Messer (US5991740).

As to claim 8, the difference between the claim and Koprowski is the claim recites: wherein the web site of the manufacturer or vendor is a site page specifically set up to receive referrals from another web site and to compensate the owner of the referring web site. Messer discloses a method and system for carrying out electronic commerce similar to that of Koprowski. In addition, Messer further teaches a site page set up to receive referrals from another web site and to compensate the owner of the referring web site (col. 3, Ln. 25-30; Col. 4, Ln. 47-60; col. 9, Ln. 50-55). It would have been obvious to one of ordinary skill in the art, having the disclosures of Koprowski and Messer before him at the time the invention was made, to modify the web page of Koprowski to link to a vendor web site, as in Messer. One would have been motivated to make such a combination because the ability of widespread advertising and promotion for a part/item would be achieved, as taught by Messer.

As to claim 17, Messer teaches: wherein the web site of the manufacturer or vendor is a site page specifically set up to receive referrals from another web site and to compensate the owner of the referring web site.

Response to Arguments

7. Applicant's arguments filed on 01/04/05 have been fully considered but they are not persuasive.

Applicant argues that the only thing similar about Allsop and Koprowski is that they both use the World Wide Web and are concerned with e-commerce. The arguments reiterate that both references are from the same field of endeavors and therefore are combinable. Applicant further argues that the entire purpose of Allsop is to "provide a customized user interface for ordering products only from the one specific manufacture and dealer." Contrary to applicant's arguments, although Allsop discloses ordering product only from the one specific manufacturer but Allsop still discloses a plurality of manufacturers as seen in fig. 5 wherein users can select from to place an order for a products that they want to purchase. As far as claims 19 and 20 that call for displaying of model part numbers by clicking on the name of the manufacturer, Koprowski discloses such limitations (see rejection above). Applicant's argument are deemed unpersuasive, claims 1, 5-11, 14-17, 19 and 20 stand rejected.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (703) 305-3973. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronald Laneau

Ronald Laneau
Examiner
Art Unit 3627

3/3/05

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